

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDMUND HULIN JAMES III

Appeal No. 2001-2198
Application 09/378,802

ON BRIEF

Before PATE, NASE, and BAHR, Administrative Patent Judges.

PATE, Administrative Patent Judge.

DECISION ON APPEAL

This is appeal from the final rejection of claims 1 and 9. Claims 3 through 8 and 10 through 15 stand allowed. Claim 2 has been canceled. These are all the claims in the application.

The claimed invention is directed to a method and apparatus for increasing the waste ink storage area in an inkjet printer. A rotary spreader mechanism is moved in response to the printhead to disperse waste ink in a waste ink accumulation region.

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The claimed subject matter may be further understood with reference to claims 1 and 9 as appended to appellant's brief.

The references of record relied upon as evidence of anticipation and obviousness are:

Osborne et al. (Osborne)	5,896,145	Apr. 20, 1999
Taylor et al. (Taylor)	5,980,018	Nov. 9, 1999
		(filed July 3, 1996)

Claim 1 stands rejected under 35 U.S.C. § 102 as anticipated by Osborne.

Claim 9 stands rejected under 35 U.S.C. § 103 as unpatentable over Taylor.

For the complete statement of the examiner's rejection, reference is made to the examiner's answer. Reference is also made to the appeal brief and reply brief for the appellant's response thereto.

OPINION

As was held in *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997):

the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.

In interpreting the claim terms "engage" and "disperse" as found in claim 1, these claim terms are not otherwise defined in the specification, and we give them their ordinary and customary meanings. "Engage" means to contact, and "disperse" means to spread widely or disseminate. Turning to the Osborne patent, it is our opinion that Osborne cannot be said to comprise a mechanism that disperses waste ink. Osborne's disclosure is clear. A rotating "ferris wheel" spittoon 70 receives ink from pens 30, 32 when they are located above the spittoon in spitting position. The ink is spit through aperture 86 directly onto the spittoon 70. To remove the ink from the spittoon, the spittoon is rotated so that scraper blade 90 scrapes ink from the annular bottom portion 82, and the ink falls by gravity into pile 96. Any residual liquid may be absorbed by diaper 91. We are in agreement with the examiner that "engage" is a relatively broad term, and the spittoon 70 of Osborne can be said to move in rotary motion and engage spitted ink. However, we do not view the action of Osborne in rotating the ferris wheel spittoon and scraping as "indirectly" dispersing waste ink by the scraper 90. The section 102 rejection of claim 1 is reversed.

Turning to the obviousness rejection of claim 9, Taylor discloses a schematic inkjet printer service station in Fig. 2. In this embodiment, pallet 62 is moved in direction 66 to service the printer heads. This direction is orthogonal to the direction of printhead movement 42 shown in Figure 1. The examiner advances two theories of obviousness based on Taylor. First, in the final rejection, the examiner states that as is conventional in this art either the printhead must be moved relative to the service area, or the service area must move relative to the printhead to effect cleaning. Although, Osborne moves the service area, the examiner is of the view that it would have been obvious to move the printhead instead, citing *In re Malcolm*, 129 F.2d 529, 54 USPQ 235 (CCPA 1942). Used in this manner, the *Malcolm* case amounts to a *per se* rule of unpatentability. The use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention--including all its limitations--with the teachings of the prior art, flouts section 103 and the fundamental case law applying it. *Per se* rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board.

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Indeed, they have been sanctioned by the Board as well. But reliance on *per se* rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with section 103, which, according to *Graham v. John Deere, Co.*, 383 U.S. 1, 17-18, 148 USPQ 456, 466 (1966) and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention as claimed in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations. *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995).

In the answer, the examiner states that the printhead has to first move the printhead into the home position over the service area and that this movement satisfied the claim limitation of spreading ink accumulation based on printhead movement. While it is undoubtedly true that the printhead of Taylor moved into the servicing region of the printer, it cannot be said that spreading

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of waste ink was based on this movement. This is contrary to the plain meaning of the language of the claim. The section 103 rejection of claim 9 is reversed.

REVERSED

WILLIAM F. PATE III)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JEFFREY V. NASE)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

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Lexmark International, INC.
Intellectual Property Law Department
740 West New Circle Road
BLDG. 082-1
Lexington, KY 40550-0999